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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,483	09/19/2003	Manuel Becerra	006128/260159	4368
826 7590 07/16/2008 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER COBANOGIU, DILEK B	
			ART UNIT	PAPER NUMBER
			3626	
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			07/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/664,483

Applicant(s)

BECERRA ET AL.

Examiner

DILEK B. COBANOGU

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 17, 19-27, 29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 17, 19-27, 29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/21/04, 1/9/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment received on 5/28/2008.

Claims 1-8, 17, 19-27, 29, 31-33 remain pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 17, 19-25, 27, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (hereinafter Becker) (U.S. Patent Publication No. 2002/0165741 A1) in view of Levison (U.S. Patent Publication No. 2002/0010599 A1).

A. Claim 1 has been amended now to recite a method of providing insurance to a customer, said method comprising the steps of:

- i. selling, by a first party, a particular article of personal property to said customer (Becker; abstract, paragraph: 0013);
- ii. selling, by said first party, a service contract to said customer, said service contract providing protection against the mechanical breakdown or other failure of said article of personal property (Becker; abstract, paragraph: 0013, 0015); and

iii. in response to said customer purchasing said service contract, providing, at no cost to said customer, insurance coverage that protects said customer against loss of said article of personal property, , wherein: said service contract is provided by a first provider and said insurance coverage is provided by a second provider, said first and second providers being different entities (Becker; abstract, paragraph: 0013, 0015, 0018), and said insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party.

Becker fails to expressly teach "insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party". However, this feature is well known in the art, as evidenced by Levison.

In particular, Levison discloses "insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party" (Levison; paragraphs: 0006 and 0034).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Levison with the motivation of providing an incentive for a consumer to conduct business with a commercial enterprise (Levison; paragraph: 0006).

B. As per claim 2, Becker et al. discloses the method of claim 1, wherein said service contract provides protection against accidental damage to said item (Becker et al.; par. 0008).

C. As per claim 3, Becker et al. discloses the method of claim 1, wherein said step of providing said insurance coverage is done in order to permit the provision of said insurance coverage without its sale by an insurance agent (Becker et al.; par. 0014).

D. As per claim 4, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a retailer selling said item to said customer (Becker et al.; par. 0015).

E. As per claim 5, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a manufacturer of said item (Becker et al.; par. 0015).

F. As per claim 6, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a service provider that provides service or functionality for said item (Becker et al.; par. 0015).

G. As per claim 7, Becker et al. discloses the method of claim 1, further comprising the step of providing said service contract and said insurance coverage to said customer within a product protection program (Becker et al.; par. 0016).

H. As per claim 8, Becker et al. discloses the method of claim 7, wherein said product protection program is referred to by a single identification indicia (Becker et al.; par. 0008 and 0013).

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker et al. art.

I. Claim 17 has been amended now to recite a unified property protection program comprising:

- i. a service contract that is paid for by a first entity, said service contract providing protection against the mechanical breakdown or failure of a particular article of personal property (Becker; paragraphs: 0008, 0013); and
- ii. insurance coverage providing protection against loss of said article of personal property, (Becker; abstract, paragraph: 0013, 0015), wherein said personal property protection program is referenced by a single identification indicia

and said service contract and said insurance coverage are provided by two separate providers (Becker; paragraph: 0013, 0018)

The obviousness of modifying the teaching of Becker to include the Insurance coverage that is paid for by a second entity (as taught by

Levison) is as addressed above in the rejection of claim 1 and incorporated herein.

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker.

J. As per claim 19, Becker et al. discloses the property protection program of claim 17, wherein said service contract protects against the mechanical breakdown of one or more items (Becker et al.; 0015).

K. As per claim 20, Becker et al. discloses the property protection program of claim 17, wherein said insurance coverage protects against accidental damage to said one or more items (Becker et al.; 0015).

L. As per claim 21, Becker et al. discloses the property protection program of claim 19, wherein said insurance coverage protects against a loss other than accidental damage to said one or more items (Becker et al.; 0017 and 0018).

M. As per claim 22, Becker et al. discloses the personal protection program of claim 19, wherein said insurance coverage protects against the accidental damage to, or loss of, said one or more items (Becker et al.; 0017 and 0018).

N. As per claim 23, Becker et al. discloses the property protection program of claim 17, wherein said first entity is a customer who has purchased an item that is covered by said property protection program (Becker et al.; 0018).

O. As per claim 24, Becker et al. discloses the property protection program of claim 23, wherein said second entity is a retailer that has sold said item to said customer (Becker et al.; 0018).

P. As per claim 25, Becker et al. discloses the property protection plan of claim 23, wherein said second entity is a service provider that is to provide service or functionality for said item (Becker et al.; 0018).

Q. As per claim 27, Becker et al. discloses the property protection program of claim 17, wherein said property protection program provides that: (1) in response to said second entity failing to submit timely payment for said insurance coverage, said insurance coverage will be interrupted; and (2) said service contract will not be interrupted in response to said second entity failing to submit timely payment for said insurance coverage (Becker et al.; 0015 and 0018).

R. Claim 29 has been amended now to recite the property protection program of claim 27, wherein said product protection program provides that: (1) in response to said first entity failing to submit timely payment for said service contract, said first property coverage will be interrupted; and (2) said insurance coverage will be interrupted in response to said first entity failing to submit timely payment for said service contract (Becker et al.; 0015 and 0018).

4. Claims 26, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (hereinafter Becker) (U.S. Patent Publication No. 2002/0165741 A1), Levison (U.S. Patent Publication No. 2002/0010599 A1) and further in view of Rydbeck (U.S. Patent No. 6,519,470).

- A. As per claim 26, Becker et al. discloses the property protection plan of claim 23.

Becker et al. fails to expressly teach the second entity is a wireless carrier that provides wireless service for said item. However, this feature is well known in the art, as evidenced by Rydbeck.

In particular, Rydbeck discloses a wireless carrier that provides wireless service (Rydbeck; col. 2, lines 21-48).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Rydbeck with the motivation of manufacturers of wireless communications devices provide a time limited warranty (Rydbeck; col. 1, lines 15-17).

- B. As per newly added claims 31, 32 and 33, Becker et al. discloses the method of claims 1, 31 and 26.

Becker et al. fails to expressly teach the first party is a wireless carrier and particular article personal property is a cellular phone. However, this feature is well known in the art, as evidenced by Rydbeck.

In particular, Rydbeck discloses the first party is a wireless carrier and particular article personal property is a cellular phone (Rydbeck; col. 2, lines 21-48, col. 3, lines 13-26).

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Becker's system of registration and loss

protection services including a retailer, a consumer, and an insurer, which provides a lower cost protection to consumers with Rydbeck's system including a telecommunications service provider (wireless carrier) and a product as a cellular telephone with the motivation of including a sale and activation of a cellular telephone (Rydbeck; col. 3, lines 19-26).

Response to Arguments

5. Applicant's arguments filed 5/28/2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.

A. In response to Applicant's argument about Becker does not teach "selling a service contract and providing insurance coverage to a customer, wherein said service contract is provided by a first provider and said insurance coverage is provided by a second provider, said first and second providers being different entities"; Examiner respectfully submits that Becker teaches "...Also included in system 100 is an insurance provider 110 (hereinafter "insurer") which is under a contractual arrangement with one of entities 112, 102, 104, or 106 to pass along loss protection services to a consumer 108 which allows the insurance to be at a cost lower than the selling price at retail, making it less expensive and more convenient to obtain protection." in paragraph 0013 (104 and 106 represents a wholesaler, a dealer or the first entity).

B. In response to Applicant's argument about Becker does not teach "a single identification indicia"; Examiner respectfully submits that the specification of the present invention describes the single identification indicia as a plan number (paragraph 0004), and Becker teaches a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer and all relevant information may be registered into a database for tracking, identification, protection and recovery purposes (Becker; abstract). Examiner considers that since there is a database and registration of the customer and the product, there should be an identification number, or plan number for the customer and the product.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DILEK B. COBANOGLU whose telephone number is (571)272-8295. The examiner can normally be reached on 8-4:30.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. B. C./
Examiner, Art Unit 3626
6/26/2008

/Robert Morgan/
Primary Examiner, Art Unit 3626